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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,761	11/26/2003	John Gavin MacDonald	KCX-1068 (19800)	9700
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			11/18/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/723,761

Applicant(s)

MACDONALD ET AL.

Examiner

Ginger T. Chapman

Art Unit

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on August 18, 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 17, 18, 22-28 and 32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17, 18, 22-28 and 32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. In view of the appeal brief filed on August 18, 2008, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Tatyana Zalukaeva/

Supervisory Patent Examiner, Art Unit 3761.

Status of the claims

2. Claims 17-18, 22-28 and 32 are pending in the application; claims 1-16, 19-21, 29-31 are 33 are cancelled.

Claim language interpretation

3. With respect to claim 1, line 6, it is noted that the claim language “wrapped” has not been specifically defined by Applicants and thus will be given its broadest customary interpretation, i.e. the dictionary definition, in light of the Specification. The instant Specification, in particular at p. 5, ll. 12-14 and ll. 19-20; p.11, ll. 1-2 and 18-26; p. 12, ll. 4-7; p. 13, ll. 16-125; p. 14, ll. 4-5 and ll. 8-11; p. 15, ll. 6-7 and 10-20; discloses that strips or tissue coated with the ink are placed at the ends of the core, above or below layers of the napkin, around a pledget or absorbent core lengthwise with sides left open.

4. The dictionary definition of “wrapped”:

transitive verb 1 a: to cover especially by winding or folding b: to envelop and secure for transportation or storage : BUNDLE c: ENFOLD , EMBRACE d: to coil, fold, draw, or twine (as string or cloth) around something 2 a: SURROUND , ENVELOP b: to suffuse or surround with an aura or state <the affair was *wrapped* in scandal> c: to involve completely : ENGROSS —usually used with *up* 3: to conceal or obscure as if by enveloping 4: to enclose as if with a protective covering 5: to finish filming or recording <*wrap* a movie> *intransitive verb* 1: to wind, coil, or twine so as to encircle or cover something 2: to put on clothing : DRESS —usually used with *up* 3: to be subject to covering, enclosing, or packaging —usually used with *up* 4: to come to completion in filming or recording.

5. Therefore, in light of the specification and the dictionary definition of “wrapped”, the claim terminology “wrapped” is interpreted as to cover the absorbent core with one or more of the sides left open.

6. With respect to claim 1, line 7, it is noted that the claim language “coating” has not been specifically defined by Applicants and thus will be given its broadest customary interpretation, i.e. the dictionary definition, in light of the Specification. The instant Specification, in particular at p.7, l. 26 to p. 8, l. 2 and within the samples, table p. 9, ll. 14-18, discloses that the activated

carbon ink of the present invention may be applied using different surface coating methods. The dictionary definition of “coating”, i.e. a thin layer or covering.

7. Therefore, in light of the specification and the dictionary definition, the claim terminology “coating” is defined as a thin layer or covering that may be applied using different surface coating methods.

8. With respect to claim 1, line 7, it is noted that the claim language “durable” has not been specifically defined by Applicants and thus will be given its broadest customary interpretation, i.e. the dictionary definition, in light of the Specification. The instant Specification, in particular at p. 10, ll. 1-24, discloses measuring durability by various tests including finger-rubbing with little or no sorbent left on the fingers, and by a Taber Abrasion test.

9. The dictionary definition of “durable”: from the Latin, *durabilis*, from *durare*, “to last”. The dictionary does not specify a minimum or maximum time of duration. The Specification does not specify a period of time beyond the duration of the finger-rubbing/Taber test. Therefore, in light of the specification and the dictionary definition, the claim terminology “durable” is deemed to define an ink that is durable in a manner that when a substrate coated with the ink is rubbed between a thumb and forefingers or rubbed between a thumb and a hard substrate, little or no ink is left on the fingers.

10. With respect to claim 1, line 7, the claim language “activated carbon ink” is defined as set forth on page 3, line 24 of the specification, i.e. odor sorbent, binder and water.” Odor sorbent, disclosed generally at p. 4, ll. 1-12, may be zeolites, silicas, aluminas, titanias, sodium carbonates, sodium bicarbonates, sodium phosphates, zinc and copper sulfates and activated carbon or other chemicals known to control odors, and mixtures thereof; specifically, Nuchar

PMA Ink and DPX-7861-49A commercially available from MeadWestvaco Corporation of New York, NY, USA. Therefore, in light of the specification, the terminology “activated carbon ink” is defined as substantially odor sorbent, binder and water. The examiner notes that the water is removed from the substrate after coating/saturation by drying.

Claim Rejections - 35 USC § 112

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim recites, “wrapped around” to mean that “one or more sides of the core are left open”. However, by way of example, if all sides except one are left open, this reads on “wrapped” as claimed, but contradicts the meaning of wrapped commonly understood in the art.

13. The primary purpose of this requirement of definiteness of claim language is to ensure that the scope of the claims is clear so the public is informed of the boundaries of what constitutes infringement of the patent. MPEP §§2173, 2173.01 [R-2].

14. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term “wrapped around” in claim 1 is used by the claim to mean “one or more sides are left open”,

while the accepted meaning is "to cover." The term is indefinite because the specification does not clearly redefine the term.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

17. Claims 17, 18 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujinami et al (US 3,939,838) in view of Onishi et al (JP 2002015147).

18. The examiner notes that EP 1,331,015 A2 is an English language equivalent of JP '147; therefore, although a translation is provided for '147, reference is made to EP '015.

19. With respect to claim 17, as seen in Figures 2 and 5, Fujinami teaches a personal care product comprising: a liquid impervious baffle 25, 55, a liquid pervious liner 22, 52; an absorbent core 23, 53 positioned between baffle and liner; and an odor sorbent substrate 26, 56

(c. 3, ll. 23-24) positioned between the baffle and the absorbent core (c. 3, ll. 32-34) and wrapped around the absorbent core in a manner that all sides except the bottom side are left open, i.e. “one or more sides are left open” as presently recited in claim 17, wherein the substrate (26) comprises activated carbon ink comprising active carbon particles and ion exchange resin (c. 3, ll. 36-38; ll. 46-48). Resins are known in the art to provide binding properties as a function of ionic strength. Therefore, absent evidence to the contrary, the ion exchange resin in the activated carbon ink formulation of Fujinami is considered a binder.

20. With respect to the limitation of the ink being durable, as a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith. *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972). The prior art of record does not perform durability tests and therefore do not specify a minimum or maximum durability of the carbon ink. The prior art teaches the odor sorbent carbon ink comprised of substantially the same materials and applied in substantially the same manner. The prior art teaches the ink endures for in use conditions in its normal and usual function. It is known that normal and usual in use conditions include walking, sitting and other motion activities that would be comparable to the instant disclosed rubbing and abrasion tests. Therefore, absent evidence to the contrary, the examiner is considering the durability of the prior art to encompass normal and usual rubbing and abrasion or chaffing in wear conditions and thus meets the claimed durable ink.

21. Fujinami discloses the claimed invention except for the odor sorbent substrate wrapped around the absorbent core in a manner that more than one side is wrapped. Although not expressly recited in the claims as presently written, see rejection of claim 1, *infra* under the

heading "*Claim Rejections - 35 USC § 112*", this feature is addressed due to indefiniteness of the claim.

22. As seen in Figures 5 and 6, Onishi discloses a personal care product 40 comprising: a liquid impervious baffle 48; liquid pervious liner 52; an absorbent core therebetween 44; and an odor sorbent substrate 42 positioned between the baffle and the core and wrapped around the core. Additionally, Onishi teaches, at [0038-9] that an odor sorbent substrate can be placed in many configurations along and around the sides of an absorbent core. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to wrap the substrate of Fujinami as taught by Onishi since Onishi states, at [0038-9], that the benefits of wrapping the substrate around and along the surfaces core is that, since the odor escapes from the surfaces of the core, arranging the odor sorbent substrate at any of the surfaces of the core provides the most efficient absorbing of odor generated.

23. In view of the many wrapping arrangements taught in the prior art, mere changes in wrapping configurations of the sorbent without change in its respective function of absorbing odor is an obvious modification and does not lend additional patentable weight. Were this not the case, multiple patents could issue indefinitely on the same invention.

24. With respect to claim 18, Fujinami teaches the personal care product is a sanitary napkin.

25. With respect to claims 25 and 26, Fujinami teaches airlaid paper web (c. 3, ll. 35-40).

26. With respect to claim 27, as best depicted in Figure 4, Fujinami teaches the substrate (44) contains a film (c. 3, ll. 30-31 and c. 2, ll. 47-50).

27. Claims 28 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujinami/ Onishi and further in view of Hu et al (US 6,740,406).

28. With respect to claim 28, the combination of Fujinami and Onishi disclose the claimed invention except for the binder is styrene-acrylic binder. Fujinami teaches ion exchange resin in the sorbent formulation. Hu, at c. 10, l. 9, teaches styrene-acrylic binder. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the carbon of Fujinami with the binder of Hu, since Hu states, at c. 9, ll. 5-10 that the benefit of adding binder is that it holds the activated carbon together and to a substrate and thus provides useful physical properties.

29. With respect to claim 32, the combination of Fujinami and Onishi discloses the claimed invention except for the ink is applied to the substrate as an aqueous solution. Hu, at c. 4, ll. 34-40, teaches the ink is applied to the substrate as an aqueous solution. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to apply the ink of Fujinami / Onishi as an aqueous solution as taught by Hu with a reasonable expectation of success since applying an aqueous solution to a substrate is applying a known technique to a known product to yield the predictable result of coating the substrate.

30. Claims 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujinami/Onishi in view of Giglia et al (US 4,565,727).

31. With respect to claim 22-24, Fujinami/ Onishi disclose the claimed invention but do not expressly disclose the carbon particles are present in a range of between about 2 and 80 weight % of the substrate on a dry basis. As seen at c. 1, l. 1. Giglia teaches activated carbon particles are 15-80 wt. % of the substrate for increased sorption, suggesting that the greater the desired absorption, the greater the amount of activated carbon particles. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the

activated carbon particles of Fujinami/ Onishi in the claimed ranges for the desired degree of adsorptiveness with a reasonable expectation of success since it has been held that when the claimed range and the prior art range are very similar, (i.e. about 2 to 80 % and about 15 to 80 %), the range of the prior art establishes *prima facie* obviousness because one of ordinary skill in the art would have expected the similar ranges to have the same properties. See *In re Peterson*, 65 USPQ2d 1379, 1382. Furthermore, the disclosure by the reference of a preferred embodiment does not teach away from the entire disclosure of the patent, all of which must be considered in the analysis of obviousness. See *In re Burckel*, 201 USPQ 67, 70.

Response to Arguments

32. Applicant's arguments filed August 18, 2008 have been fully considered but they are not persuasive. Applicants' arguments are addressed in the rejection *infra*.

Conclusion

33. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

34. Yeo et al (US 5,122,407) teaches an odor sorbent substrate covering the top and sides of an absorbent core (fig. 1).

35. Karapasha (US 5,407,442) teaches an activated carbon ink comprised of carbon particles and binders.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ginger T. Chapman whose telephone number is (571)272-4934. The examiner can normally be reached on Monday through Friday 9:30 a.m. to 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tatyana Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ginger T Chapman/
Examiner, Art Unit 3761
11/7/08

/Tatyana Zalukaeva/
Supervisory Patent Examiner, Art Unit 3761